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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 0925-0165P | | | | | | | | | | |
|--|--|--|--|---|---|---|---|--|---|------------------------------------|--|-----------------------|
| | Application Number 09/757,645-Conf. #8027 | Filed January 11, 2001 | | | | | | | | | | |
| | First Named Inventor Satoaki NAKAGAWA et al | | | | | | | | | | | |
| | Art Unit 2621 | Examiner H. T. Nguyen | | | | | | | | | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table><tr><td><input type="checkbox"/> applicant /inventor.</td><td rowspan="2"> Signature</td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/96)</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record Registration number 29,680</td><td> Typed or printed name Michael K. Mutter</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</td><td>(703) 205-8000 Telephone number</td></tr><tr><td></td><td>June 25, 2007 Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of 1 forms are submitted</p> | | | | <input type="checkbox"/> applicant /inventor. |  Signature | <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/96) | <input checked="" type="checkbox"/> attorney or agent of record Registration number 29,680 |  Typed or printed name Michael K. Mutter | <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 | (703) 205-8000 Telephone number | | June 25, 2007 Date |
| <input type="checkbox"/> applicant /inventor. |  Signature | | | | | | | | | | | |
| <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/96) | | | | | | | | | | | | |
| <input checked="" type="checkbox"/> attorney or agent of record Registration number 29,680 |  Typed or printed name Michael K. Mutter | | | | | | | | | | | |
| <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 | (703) 205-8000 Telephone number | | | | | | | | | | | |
| | June 25, 2007 Date | | | | | | | | | | | |

Docket No.: 0925-0165P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Satoaki NAKAGAWA et al.

Application No.: 09/757,645

Confirmation No.: 8027

Filed: January 11, 2001

Art Unit: 2621

For: SIGNAL RECEIVER

Examiner: H. T. Nguyen

REQUEST FOR A PRE-APPEAL BRIEF CONFERENCE

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dated: June 25, 2007

Sir:

INTRODUCTORY COMMENTS

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request.

The request is being filed concurrently with a Notice of Appeal.

The review is being requested for the reasons set forth on the attached five (5) sheets.

REMARKS

Applicants respectfully submit that the Examiner has made the following clear error:

The Examiner is improperly interpreting and applying the prior art in rejecting independent claims 1, 8, and 14 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,185,360 to Inoue et al. ("Inoue") in view of the admitted prior art ("APA") discussed on pages 1-3 of the specification.

1. Inoue fails to disclose a first memory and an alarm device as disclosed in the rejected independent claims.

Independent claim 1 defines a signal receiver for displaying received broadcast electric waves. The signal receiver includes, *inter alia*, **a first memory** for storing, as a past record, information representing *whether the signal receiver was previously subjected to an initial setup*, and **an alarm device** for *alarming the necessity of the initial setup* of the signal receiver, which is activated by a processing device, *when a connection of a power source plug to an external power source is detected* by said processing device and no past record exists in the first memory, whereby a user performs the initial setup using a guided setup which is initiated in response to the alarm device and/or an activation device being activated.

Inoue merely discloses an information receiving apparatus and method for automatically recording reserved programs when the recording time of the reserved programs overlap. According to the method of Inoue, the system determines or judges which of the overlapping programs is to be recorded based on additional program information. Particularly, Inoue discloses a controller 23h, which detects this overlapping of recording time of programs and a comparing and determining means 23g, which determines which of the overlapping programs is to be recorded. Although Inoue discloses a first memory unit 25 and a second memory unit 26, nowhere in Inoue is there any disclosure or suggestion that these memory units (25, 26) store, as a past record, *information representing whether the signal receiver was previously subjected to initial setup*. Further, Inoue is completely silent on whether there is any alarm device for *alarming the necessity of the initial setup* as claimed.

In rejecting claim 1, the Examiner asserts that Inoue discloses a first memory as claimed inasmuch as Inoue discloses storing as reserved programs, programs which are to be recorded. However, nowhere in Inoue is there any disclosure or suggestion of *storing information regarding whether or not the receiver has been subjected to an initial setup*. As demonstrated above, Inoue merely discloses memory for storing program information and a controller for automatically determining which of the overlapping programs is to be recorded. Accordingly, it is respectfully submitted that Inoue cannot teach or suggest the above-identified claim features of independent claim 1. Independent claim 8 is directed to an electronic receiver and claim 14 is directed to a method for programming the electronic receiver, both of which recite the above-identified claim features of independent claim 1 in a similar manner. Thus, it is respectfully submitted that independent claims 8 and 14 are distinguishable over Inoue. APA has not been, and indeed cannot be, relied upon to fulfill at least this deficiency of Inoue. Thus, it is further respectfully submitted that even if one skilled in the art were motivated to combine Inoue and the APA, which Applicants do not concede, the combination would still fail to render claims 1, 8, and 14 unpatentable because the combination fails to disclose each and every claimed element.

2. APA fails to disclose any step or structure for detecting a connection of a power source plug to an external power source.

The Examiner acknowledges that Inoue fails to disclose a step or structure for detecting a connection of a power source plug to an external power source as disclosed in independent claims 1 and 8. Thus, the Examiner imports APA to fulfill this deficiency of Inoue. The Examiner relies on Fig. 2 and pages 1-3 of the instant specification as disclosing such feature. Particularly, the Examiner contends that APA teaches that setup of the apparatus is performed in a power-on state, and therefore, a connection between the apparatus and an external power source is detected. *See page 5, section 7 of the Office Action*. It is respectfully submitted that the Examiner's interpretation of the relied upon section of APA is clearly erroneous. The relied upon section merely discloses that a signal receiver (VCR) and a display device (TV) are subjected to a predetermined wiring connection and that a menu key of a remote controller for the VCR is pushed to display a menu on the TV under the state that the VCR is under a power-on state. *See page 2, lines 1-7 of the specification*. There is no disclosure in APA that a connection

between the VCR and an external power source is detected as claimed by independent claims 1 and 8.

3. No motivation to combine Inoue and APA.

With regard to the motivation to combine Inoue with the APA, the Examiner asserts that it would have been obvious to one skilled in the art to modify “Inoue with the admitted prior art by providing [the] Inoue apparatus with a control means as taught by the admitted prior art for detecting a connection of the power source with an external power source thereby enhancing the capacity of the Inoue apparatus for further controlling the receiver.” This assertion is unfounded for the following reasons.

First, the mere fact that references can be combined is not sufficient in and of itself to render the resultant combination obvious, absent some evidence of the desirability of the modification. Nowhere in the cited references, or the Office Action, is there any evidence or suggestion of the desirability of detecting the connection of a power source plug to an external power source. It is respectfully submitted that the rejection of independent claims 1, 8, and 14 is a blatant string of substitutions gleaned from and motivated by the Applicants’ own patent application. The Office Action has not shown that the prior art provides the teaching or suggestion to make the claimed combination and a reasonable expectation of success. Clearly, the Examiner’s alleged motivation for the combination of Inoue and the APA is improperly based on hindsight reconstruction.

Second, as demonstrated above, nowhere in the APA is there any disclosure or suggestion of detecting means for detecting the connection of a power source plug to an external power source, much less than the addition of such a detecting means would enhance the capacity of the Inoue apparatus to control the receiver. Accordingly, absent proper motivation to combine Inoue and the APA, the rejection of independent claims 1, 8, and 14 is improper.

Dependent claims 2 and 9-13 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Inoue in view of APA and further in view of various combination of Yoshimoto (Japanese Patent Publication No. 08-065661), Nagano et al. (US 6,370,317) and Yoshida (US 5,517,321). These rejected dependent claims are at least allowable by virtue of

their dependency on corresponding independent claim. Further, Applicants respectfully submit that Yoshimoto, Nagano, and Yoshida each fails to overcome the deficiencies of Inoue and the APA as demonstrated above. Yoshimoto merely discloses a satellite broadcasting tuner/receiver that indicates whether or not the settings associated with each channel have been modified from their initial setting. Nagano discloses an apparatus and method for controlling the recording of television programs. Yoshida discloses a video tape recorder that measures the time remaining on a tape and compares it with the time programmed for a timer recording. However, none of them teach or suggest a signal receiver that includes a first memory or an alarm device as claimed. Further, none of them teaches or suggests a step or structure for detecting a connection of a power source plug to an external power source.

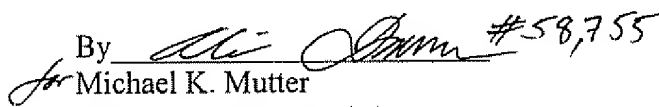
Conclusion

In view of the foregoing, Applicants respectfully submit that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited. Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Ali M. Imam (Reg. No. 58,755) at (703) 205-8000 **to schedule a Personal Interview.**

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: June 25, 2007

Respectfully submitted,

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